

REMARKS

Claims 7, 37, 39, 41-43, 45-52, 55-60 and 62-87 are pending. Applicants have amended claims 7, 49, 73-76, 81-83, and 85 to more particularly point out and distinctly claim the subject matter Applicants regard as their invention. New claim 87 derives from previously withdrawn claim 7, as fully explained below. Applicants submit that the amendments contain no new matter, in accordance with the requirements of 37 C.F.R. § 1.121(f).

I. 35 U.S.C. §112, Second Paragraph

The Office has rejected claims 73-76, 82, and 83 under 35 U.S.C. §112, second paragraph, as allegedly being indefinite. (Office Action at page 3.) The Office believes that the phrase “comprising HCMV pp28” in claim 37 is indefinite because pp28 is the name of a viral protein and not the name of the DNA that encodes it. The Office has suggested amending these claims by using the terms “gene” and/or “encoding.” (Office Action at page 3). As suggested, Applicants have amended the “comprising” language to “encoding” in claims 73-76, and 82-83. Therefore, Applicants request that this rejection be withdrawn. Applicants further note that these amendments would also place dependent claims 41-43, 45-52, 58 -60, 65-72, and 80 in condition for allowance.

II. 35 U.S.C. §112, First Paragraph

The Office has rejected claims 77-79, 81, 84-86, and 55-57 under 35 U.S.C. §112, first paragraph, for allegedly failing to comply with the written description requirement. (Office Action at 3-4.) The Office acknowledges that the specification broadly discloses

prokaryotic and eukaryotic cells and vectors, but believes that it does not disclose specific eukaryotic cell types for any pp28 expression, nor specific prokaryotic vector and cell types for expressing the entire pp28. (Office Action at 5). The Office has invited Applicants to point to support in the specification for these claims. The specification discloses specific prokaryotic vector and cell types for pp28 expression, for example, see p. 3., lines 1-13, which discloses the *E. coli* strain Y 1089 and a bacteriophage expression vector; p. 2, lines 32-35, and p. 3. lines 1, 5-8, which discloses lambda gt11 phages; and p. 3 lines 5-9, which discloses a prokaryotic expression vector which encodes a fusion protein. While the combination of these prokaryotic cell types and vectors are specifically disclosed for expressing antigenic *portions* of pp28, the Office admits that the specification broadly discloses prokaryotic cells and vectors, and one of skill in the art given applicants disclosure would understand that the these same combinations of specific cell types and vectors could be used to express the entire pp28, and that Applicant's had possession of the claimed invention.

Similarly, the specification also discloses specific eukaryotic cell types which could be used for pp28 expression, for example see p. 2, lines 9-14, which discloses the use of human fibroblast cells. The Office admits that the specification broadly discloses eukaryotic cells and vectors, and one of skill in the art given applicants disclosure would understand that the these same combinations of specific cell types and vectors could be used to express the entire pp28 or antigenic portions, and that Applicant's had possession of the claimed invention.

Additionally, “[t]he examiner has the initial burden of presenting by a preponderance of evidence why a person skilled in the art would not recognize in an applicant’s disclosure a description of the invention defined by the claims.” MPEP §2163.04. For these reasons, Applicants request that this rejection be withdrawn.

III. Rejections Based on Informalities

The Office has pointed out two spelling errors in claims 81 and 85. Claims 81 and 85 have been amended to correct these. Similarly, the spelling of *E. coli* has been amended in claim 49.

IV. Rejoinder Of Claim 7

The Office has previously subjected claims 7 and 8 to a restriction requirement, containing Group 1 claims (directed to methods of making pp28 protein) and Group II claims (directed to DNA and host cells encoding pp28). Applicants elected to prosecute the Group II claims under the transitional restriction practice pursuant to 37 CFR § 1.129(b)(3). “[I]f the elected invention is directed to the product and the claims directed to the product are subsequently found patentable, process claims which either depend from or include all the limitation of the allowable product will be rejoined.” MPEP § 821.04 (emphasis in original).

As discussed by telephone with the Examiner, claims 73 and 74, previously rejected for indefiniteness, may now become allowed because Applicants have entered the Examiner’s suggested amendments. Claim 73 is directed to prokaryotic expression vectors encoding the *entire* HCMV pp28, and Claim 74 is directed to prokaryotic

expression vectors encoding *antigenic portions* of HCMV pp28. Applicants now wish to rejoin withdrawn claim 7 which is directed towards a method for making those products.

“In the event of rejoinder, the rejoined process claims will be fully examined for patentability . . . If the application containing the rejoined claims is not in condition for allowance, the subsequent Office action may be made final, or, *if the application was already under final rejection, the next Office action may be an advisory action.*” MPEP §821.04 (emphasis added)

As discussed with the Examiner, in an effort to put claim 7 in condition for allowance, Applicants wish to amend claim 7, and enter a claim derived from claim 7. Claim 7 as originally drafted depended on claim 17, claim 17 has been cancelled and replaced with claims 73 and 74. Applicant’s amended version of claim 7 and claim 87 (derived from claim 7) depend from and include all the limitations of the potentially allowable product claims 73 and 74 and therefore should be rejoined and allowed. Applicants intend to cancel withdrawn claim 8 when and if claim 7 and 87 get rejoined.

If the Examiner has any further suggestions, or guidance regarding this procedure please call the undersigned attorney, Scott Popma, at 202-408-4297.

FINNEGAN
HENDERSON
FARABOW
GARRETT &
DUNNER LLP

1300 I Street, NW
Washington, DC 20005
202.408.4000
Fax 202.408.4400
www.finnegan.com

CONCLUSION

Applicants respectfully request that this Amendment under 37 C.F.R. § 1.116 be entered by the Office, placing claims 7, 37, 39, 41-43, 45-52, 55-60 and 62-87 in condition for allowance. Applicants submit that the proposed amendments to claims 7, 73-76, 81-83, and 85 do not raise new issues or necessitate the undertaking of any additional search of the art by the Office, since all of the elements and their relationships claimed were either earlier claimed or inherent in the claims as examined. Therefore, this Amendment should allow for immediate action by the Office.

Finally, Applicants submit that the entry of the amendment would place the application in better form for appeal, should the Office dispute the patentability of the pending claims.

In view of the foregoing amendments and remarks, Applicants respectfully request the reconsideration and reexamination of the pending claims and the timely allowance of the pending claims.

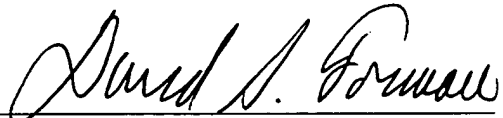
FINNEGAN
HENDERSON
FARABOW
GARRETT &
DUNNER LLP

1300 I Street, NW
Washington, DC 20005
202.408.4000
Fax 202.408.4400
www.finnegan.com

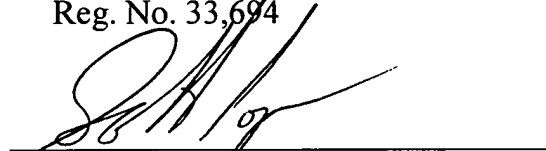
Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

By: 

David S. Forman
Reg. No. 33,694



Scott J. Popma
Reg. No 46,053

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FINNEGAN
HENDERSON
FARABOW
GARRETT &
DUNNER LLP

1300 I Street, NW
Washington, DC 20005
202.408.4000
Fax 202.408.4400
www.finnegan.com